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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,592	03/30/2001	Katayoun Atefi	END9-2000-0117US1	1255

7590 10/07/2005

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EXAMINER
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STIMPAK, JOHNNA

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/822,592

Applicant(s)

ATEFI ET AL.

Examiner

Johnna R. Stimpak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following is a non-final office action upon examination of application number 09/822,592. Claims 1-9 and 13-20 are pending and have been examined on the merits discussed below.

#### ***Response to Arguments***

2. Applicant's arguments with respect to rejections of claims 1-12 under 35 USC 102(b) and 103(a) have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments with respect to rejection of claims 6 and 9, specifically to the claimed detailed matrix, under 35 USC 112, 2<sup>nd</sup>, have been considered, but are not persuasive. The clarification of the detailed matrix is not consistent with what is disclosed in the specification. There is nothing in the specification that defines a detailed matrix as having more than 20 service attributes. In fact, on page 10 of the specification, the simple matrix is defined as having between 10 and 20 attributes, although a lesser or greater number could be used. It is not clear what difference there is between the detailed and generic matrix as claimed. New rejections under 112 have been raised in subsequent pages.

4. Examiner acknowledges the amendments to claims 6, 8 and 12 to remove reference to simple questions thereby overcoming prior rejections under 35 USC 112, 2<sup>nd</sup> paragraph. However, new rejections under 25 USC 112, 2<sup>nd</sup> paragraph follow.

5. Applicant's arguments, with respect to use of the term "workshop" in claim 9, have been fully considered and are persuasive. The rejection under 35 USC 112, 2<sup>nd</sup> paragraph of claim 9

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has been withdrawn. However, new rejections under 35 USC 112, 2<sup>nd</sup> paragraph can be found on the succeeding pages.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-9 and 13-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, Applicant describes the use of two assessment tools that are then combined to produce recommendations. However, it is not understood how results from the matrix are combined with results from the questions in a way to make recommendations. In turning to the specification, the matrix appears to be a guide for one to be able to rate or rank their feelings of satisfaction concerning attributes of the service and the questions appear to be simple yes/no questions. It is not clear how the matrix indicates customer satisfaction since there is no description of how the matrix is utilized. Does the user circle the best representation of their feeling on the attribute? Does the user somehow indicate the numeric indication of maturity level somehow? Furthermore, it is not clear how results of the matrix and results of the questions are combined to provide recommendations. For example, how does one combine numeric results, if this is the case, with yes/no type answers? The brief mention of consolidating the facts and findings and

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determining recommendations and conclusions on page 13 of the specification is vague. There is no explanation as to how the results from the matrix and the questions are combined.

8. With respect to claim 7, maturity of IT service is determined, but in turning to the specification there is no explanation that would enable one skilled in the art to make this determination. First, the delivery of IT service is evaluated, but as indicated above, this is not clear. Furthermore, in step (b), it is not clear what a “perceived IT service attribute” is and how it is compared to an “established level or IT service”. If Applicant meant to compare the perceived level of IT service with the established level of IT service, corrections must be made to the claims. If this assertion by the examiner is correct, there is no indication as to how the maturity of IT service determined from the comparison of the perceived level and the established level of IT service. Is there an algorithm or equation used to determine maturity?

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-9 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, Applicant describes the use of two assessment tools that are then combined to produce recommendations. However, it is not understood how results from the matrix are combined with results from the questions in a way to make recommendations. In turning to the specification, the matrix appears to be a guide for one to be able to rate or rank their feelings of satisfaction concerning attributes of the service and the questions appear to be simple yes/no

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questions. It is not clear how the matrix indicates customer satisfaction since there is no description of how the matrix is utilized. Does the user circle the best representation of their feeling on the attribute? Does the user somehow indicate the numeric indication of maturity level somehow? Furthermore, it is not clear how results of the matrix and results of the questions are combined to provide recommendations. For example, how does one combine numeric results, if this is the case, with yes/no type answers? The brief mention of consolidating the facts and findings and determining recommendations and conclusions on page 13 of the specification is vague. There is no explanation as to how the results from the matrix and the questions are combined.

Furthermore, claim 1 recites a matrix wherein each column/row corresponds to one IT service attribute and the columns/rows provide different levels of IT service maturity. It is not clearly understood what is being claimed. As claimed, each row can correspond to both an attribute and a maturity level. Furthermore it is not clear how the matrix provides an indication of customer satisfaction if all rows contain both attributes and maturity levels. In addition, in claim 2, it is not clear if all the rows pertain to the same attribute or if each row represents each of the attributes. Clarification to the claims is required.

Claims 6 and 9 are directed to a detailed matrix having more than twenty IT service attributes, however, a detailed matrix is never defined as such in the specification and figure 5 shows a detailed matrix, but the matrix in figure 5 only has 4 service attributes for assessment. Furthermore, on page 10 of the specification a generic matrix is defined as having "between 10 and 20 attributes, although a lesser number or a greater number could be used to advantage".

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There is an overlap in what constitutes a detailed matrix and a generic matrix. Clarification is required.

Claim 7 recites the limitation "perceived IT service attribute" in line 8 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claims 7-9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Step (b) of the claim recites "comparing perceived IT service attribute with established levels of IT service". It is not clear how one compares a "perceived attribute" with an "established level...". Clarification is required.

### ***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 and 13-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For an invention to be statutory it must produce a useful, concrete and tangible result. However, in the present case, since there is no description of how the matrix provides an indication of a customer's satisfaction, and since there is no description of how one combines the results from the matrix and the questions to make recommendations, one would not be able to use the results from the matrix to combine with the results from the questions leading to recommendations for improvement. Hence, the claimed invention is not concrete and not useful since one would not know how to make or use the invention and would thereby not result in a useful outcome. Furthermore, in determining

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maturity of IT service, there is no clear description of what a “perceived IT service attribute” is and how it is compared to an “established level of IT service”. If Applicant meant to compare the perceived level of IT service with the established level of IT service, corrections need to be made to the claims. If this assertion by the examiner is correct, there is no indication as to how the maturity of IT service determined from the comparison of the perceived level and the established level of IT service. Therefore, the determination of IT maturity is also not concrete and does not produce a useful result.

In light of the numerous rejections under 35 USC 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs and under 35 USC 101, Examiner respectfully requests applicant to thoroughly review all claims and make any necessary corrections. Furthermore, because claims 1-20 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); *Ex parte Brummer*, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.



***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Paulk et al, "Capability Maturity Model for Software, Version 1.1" – February 1993 – use of the capability maturity model and the five levels of maturity from the Software Engineering Institute (SEI) – the five levels of maturity disclosed in Paulk et al, mirror the five levels of maturity in claims 4 and 13.
- Daskalantonakis, "Achieving Higher SEI Levels" – September 1994 - based on SEI's assessment of maturity levels, with use of matrix assessments – matrix assessment in Daskalantonakis includes service attributes across the top of the matrix and scores, which are correlated to SEI levels, down the left side of the matrix.
- Voas et al, US 6,862,696 – system and method for software certification
- Gundewar et al, US 6,381,610 – system and method for implementing project procedures

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Stimpak whose telephone number is 571-272-6736.

The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS  
9/29/05



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